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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/644,777	08/23/2000	Roger P. Jackson	10,033	1641

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EXAMINER

MELSON, CANDICE C

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 08/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/644,777

Applicant(s)

JACKSON, ROGER P.

Examiner

Candice Melson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 August 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: the "radial outer surface 42", implantation thread 12", and the "outer surface 32". A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Abstract

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

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Specification

The disclosure is objected to because of the following informalities:

- in line 11 of page 10, the word "elongate" should be elongated
- line 19, page 10 the word "radially" should be radial
- the word "altough" should be although on page 11, line 14
- on page 12, line 2 there is a word missing in the phrase "the terms leading trailing"
- on line 5 of page 13 there should be a space between the phrase "3from"

Appropriate correction is required.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification lacks antecedent basis for the threadform of the first implant to be discontinuous, as set forth in Claim 11.

Information Disclosure Statement

The information disclosure statement filed October 10, 2001 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered. More specifically, German P.N. DE 29806563 U1, has not been considered by the examiner because there was no relevance stated nor was an English translation provided by the applicant. In addition the United States Patent 5,601,553 was also not considered by the examiner because

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it was not listed on the information disclosure statement. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Claim Objections

Claim 26 objected to because of the following informalities: the word said is incorrectly printed as "sail". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11, 13-16, and 20 are rejected under 35 U.S.C. 112 2nd ¶. Claim 11 recites the limitation "the combination according to Claim 1". There is insufficient antecedent basis for this limitation in the claim. More specifically, there is no combination claimed in Claim 1.

Regarding Claim 13, the phrase "rod-like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d). In addition, Claim 20 lacks antecedent basis for the phrase "the implant" in line 1.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1) Claims 1-7, 11, 17, 19-20, and 22-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Reed (USPN 5,499,892). Reed shows a “threaded shaft 50 includes threads 60 thereon which include an upper surface 66 and a lower surface 68 (FIG. 3) which extend upward toward the head 20 from a minor diameter to a major diameter 62” (column 6, lines 30-33). These threads each consist of an inner and outer edge referred to as a “crest” and a “root”. Regarding Claims 2-4, in column 8, lines 26-28, Reed discloses that “the upper surface angle” “is preferably 20° but could be any angle between 0° and 90°”. The “lower surface angle” that Reed refers to” is preferably 40° but could be any angle between 0° and 90°”. The disclosed angles encompass applicant’s claimed angles. In light of the above mentioned disclosures as well as Reed’s Figure 3, it is clear that the “upper and lower surfaces” are non-parallel, which is

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clearly in anticipation of Claim 7. As to Claim 11, note Figure 5, which shows a discontinuous threadform. With regards to Claim 17 Reed discloses that “both the crest 70 (outer edge) and root 80 (inner edge) exhibit a constant distance from the central axis 2 between the upper edge 72 and the lower edge 74 and between the top edge 82 and the bottom edge 84” (column 8, lines 10-13). In addition with an upper surface angle of 20° and a lower surface angle of 40°, it is clear that the threads would form a triangular cross-section and more specifically an obtuse triangular cross-section, as set forth in Claims 19 & 20. Claims 22-25 are also rejected for the same reasons shown above for rejections of Claims 2-4. Lastly, Reed also anticipates Claims 26 in that the trailing and leading surfaces are not parallel and both slope rearwardly.

2) Claims 1-10, 12-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Morison et al. (USPN 6,296,642). Morrison et al. discloses a medical implant, a “closure member 12 adapted to be threadedly engaged” having a “generally cylindrical” portion, a clear implication that the threads are helically wound about the body of the implant in a continuous manner (column 3, lines 50 & 66). In column 3, lines 54-59, Morrison et al further disclose a second implant, “a receiver member 11” which “includes a longitudinal or thread axis”. This device also includes “a transverse channel 16 for receiving an elongated member, which is generally perpendicular to axis 14 and bore 15”. In lines 35-42 of column 4, Morrison et al disclose that “threads 44 and 46 are reverse angle threads” meaning that the “rearward-facing thread surface” is “sloped so that, for a given cross-section of the thread through the longitudinal axis of the screw, a point is closer to the distal or forward end of the screw than a point on the rearward-facing thread surface at the crest of the thread”. In addition, “channel 16 is bounded on both sides by legs 20 of receiver member 11”. In regards to Claims 14-16, as shown in Figures 1-

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3 of Morrison et al, the leading and trailing surfaces are spaced at substantially the same radius creating a generally obtuse triangular cross-section. Referring again to the Figures presented by Morrison et al, it is clear that Claims 21 are anticipated by Figures 1-3 where β and α are shown to create a cross-section generally triangular in shape.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Candice Melson whose telephone number is (703) 305-8128. The examiner can normally be reached on 8:30am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Lucchesi can be reached on (703) 308-2698. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-2708 for regular communications and (703) 308-2708 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

ccm *ccm*
August 21, 2002

Cary E. O'Connor
Cary E. O'Connor
Primary Examiner